

Application No. 10/635,402

Reply to Office Action

*REMARKS/ARGUMENTS**The Pending Claims*

Claims 1-68 are currently pending.

Summary of the Office Action

Claims 1-68 are subject to a restriction requirement under 35 U.S.C. § 121.

Summary of Examiner Interview

Applicants thank Examiner Soroush for the courtesies extended to Applicants' representative, Caryn Borg-Breen, during the telephonic interview of October 27, 2006. The restriction requirement was discussed, consistent with the remarks set forth herein.

Discussion of the Restriction Requirement

The Office Action sets forth a restriction requirement between the inventions of Group I (i.e., claims 1-17), Group II (i.e., claims 18-60), and Group III (i.e., claims 61-68). Applicant elects, with traverse, the invention of Group I (i.e., claims 1-17) and the secondary additive species protein for further prosecution.

Applicants note that, if and when a generic claim embracing the elected species is allowed, the non-elected species, if included in dependent claims incorporating all of the limitations of the generic claim, will no longer be withdrawn from consideration since they also would be fully embraced by the generic claim. M.P.E.P. § 809.02(c). In any event, however, Applicants respectfully submit that the restriction requirement is improper for the reasons set forth herein and, therefore, request withdrawal of the restriction requirement.

The Manual of Patent Examining Procedure (M.P.E.P.) recites the requirements for a proper restriction requirement. In particular, the M.P.E.P. states that there are two criteria for a proper requirement for restriction between patentably distinct inventions: (a) the inventions must be independent, *and* (b) there must be a serious burden on the examiner in the absence of restriction. See M.P.E.P. 803. These are two separate criteria that must be satisfied to support a proper restriction requirement. The fact that both criteria must be satisfied is made

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all the more clear by the following statement in the M.P.E.P.: "If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions." (M.P.E.P. § 803 (emphasis added)). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the examiner to search and examine all of the pending claims at the same time, the examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

With respect to the present application and the outstanding restriction requirement, Applicant submits that the inventions of Groups I, II, and III are so related that there will be no serious burden on the Examiner to search and examine all of the subject matter defined by the pending claims at the same time. Applicant notes that the claims of Groups I, II, and III are all classified in the same class 424. In addition, the claims of Groups II and III are both classified in the same subclasses 422 and 423. All of the pending claims require tricalcium phosphate (TCP) having a particular average crystal size and either a particular surface area, density, and/or three-point bending strength. Many of the claims of both Groups I and II also require the presence of a secondary additive. Moreover, Group II claims relate to an article, one species of which is an implant (see, e.g., pending claim 31, which requires that the article is a bioactive implant). All of the Group III claims relate to an implant. Indeed the claims of Group III could be redrafted as proper dependent claims, based on Group II claim 18. This similarity of the subject matter encompassed by the pending claims, as well as other similarities not enumerated herein, illustrate that there would be no serious burden on the Examiner to search and examine all of the subject matter encompassed by the pending claims at the same time.

In view of the foregoing remarks, Applicants respectfully request withdrawal of the restriction requirement, such that all of the subject matter encompassed by the pending claims is considered at the same time.

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Conclusion

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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